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09/317,069	05/13/1999	SHIGETAKA TANAKA	2271/59262	8608
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COOPER & DUNHAM LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10038			POKRZYWA, JOSEPH R	
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18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/317,069	TANAKA, SHIGETAKA
	Examiner Joseph R. Pokrzywa	Art Unit 2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 November 2003.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-11 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/7/03 has been entered.

Response to Amendment

2. Applicant's amendment was received on 11/7/03, and has been entered and made of record. Currently, **claims 1-11** are pending.

Response to Arguments

3. Upon review of the cited prior art, particularly the reference of Imai *et al.* (U.S. Patent Number 6,104,504), which was cited in the Office action dated 7/15/03, as anticipating **claims 1, and 3-11**, the examiner notes that Imai can still be interpreted as anticipating these claims. However, different passages are now cited, as they are referring to a different embodiment than what was previously discussed.

4. Applicant's arguments filed 11/7/03 have been fully considered but they are not persuasive.
5. In response to applicant's arguments regarding the rejection of **claim 1**, which was cited as being anticipated by Imai *et al.*, whereby applicant argues on pages 9-11 that Imai fails to teach of comparing the identification information of the calling facsimile machine on the one hand and on the other hand prestored identification information for a plurality of different machines which have common specifications of optional frames. Upon reviewing Imai, the examiner notes that in column 5, lines 19 through 32, Imai teaches of receiving a SEP signal, which includes a document sheet number, whereby the document sheet numbers designate different destinations, as read in column 5, line 57 through column 6, line 36. Further, Imai teaches that the received document sheet number is compared with that of a document number stored in a polling queue, as read in column 5, lines 19 through 40. Because of this, one of ordinary skill in the art can recognize that Imai still teaches the limitations, as currently worded, in the claim
6. Therefore, the rejection of **claim 1**, as cited in the Office action dated 7/15/03, under 35 U.S.C. 102(e), as being anticipated by Imai *et al.*, is maintained and repeated in this Office action, with a full discussion appearing below. Further, using the same embodiment and arguments as above, the rejection of independent **claims 4-7, 10, and 11**, as cited in the Office action dated 7/15/03, as being anticipated by Imai *et al.*, is also maintained and repeated.
7. Continuing, the applicant argues on page 11 that Yoshida (U.S. Patent Number 5,671,270) fails to teach of providing a facsimile apparatus with a memory which prestores

identification information for a plurality of different facsimile machines having common specifications of optional frames, and comparing the identification information of a calling facsimile machine with the identification stored in the memory. These are similar arguments to that which was stated in the request for reconsideration dated 9/22/03. Likewise, the examiner similarly responds by stating that these limitations are found in independent claim 1, which the primary reference of Imai discloses, as discussed above. Further, the examiner notes that the reference of Yoshida is used to teach a feature taught in dependent claim 2 that the primary reference of Imai fails to specifically teach. Regardless, Yoshida still can be interpreted to provide a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (column 6, line 50 through column 7, line 25, and column 11, lines 6 through column 12, line 64, being a registered password corresponding to a PWD signal), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 11, line 39 through column 12, line 21), and *verifying* the identification information of the calling facsimile machine with the identification information prestored in the memory (column 5, line 40 through column 6, line 54, column 11, lines 6 through 16, as various protocol signals are verified if they are received). Further, Yoshida teaches that the identification information prestored in the memory comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48) and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine (column 6,

line 50 through column 7, line 25, and column 9, lines 40 through 48). Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's teachings in the system of Imai. Imai's system would easily be modified to include Yoshida's teachings, as the systems share cumulative features, being additive in nature.

8. Therefore, the rejection of dependent **claim 2**, as cited in the Office action dated 7/15/03, under 35 U.S.C. 103(a), as being unpatentable over Imai *et al.* in view of Yoshida, is maintained and repeated in this Office action.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1 and 3-11** are rejected under 35 U.S.C. 102(e) as being anticipated by Imai *et al.* (U.S. Patent Number 6,104,504, cited in the Office action dated 7/15/03).

Regarding **claim 1**, Imai discloses a facsimile communication method for performing a Group 3 facsimile communications operation using an optional frame signal (column 1, lines 9 through 55, and column 3, lines 22 through 28, being a SEP signal) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5,

line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 5, lines 19 through 32), comparing the identification information of the calling facsimile machine () with the identification information prestored in the memory (step S110 in Fig. 6, column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is “collated” (or compared) with the document sheet number of the document sheet in the queue), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (“no” in step S110 in Fig. 6, column 5, lines 31 through 40, wherein “if there is no matching document sheet, . . . the process is terminated”), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (“yes” in step S110, which proceeds to step S111 to transmit the original image, column 5, lines 31 through 40, wherein “if there is a matching document sheet, the document sheet is transmitted”).

Regarding *claim 3*, Imai discloses the method discussed above in claim 1, and further teaches that the optional frame include SUB, SEP, and PWD in conformance with the recommendation T-30 of ITU-T (column 1, lines 10 through 55).

Regarding *claim 4*, Imai discloses a facsimile communication method for performing a Group 3 facsimile communications operation using optional frame signals (column 1, lines 9

through 55) in a calling number display service mode (SEP signal included in the DTC signal, column 3, lines 22 through 58), comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5, line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), receiving a telephone number of a calling facsimile machine during a call establishing process in the calling number display service mode and a signal requesting a facsimile communications operation using an optional frame (column 6, lines 9 through 62), verifying the telephone number of the calling facsimile machine received in the receiving step with the identification information prestored in the memory (step S110 in Fig. 6, column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is "collated" with the document sheet number of the document sheet in the queue), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory ("no" in step S110 in Fig. 6, column 5, lines 31 through 40, wherein "if there is no matching document sheet, ... the process is terminated"), and executing the facsimile communications operation using the optional frame when the telephone number of the calling facsimile machine corresponds to the identification information prestored in the memory ("yes" in step S110, which proceeds to step S111 to transmit the original image, column 5, lines 31 through 40, wherein "if there is a matching document sheet, the document sheet is transmitted").

Regarding *claim 5*, Imai discloses a facsimile apparatus (see abstract, and Fig. 1) comprising memory means for prestoring identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5, line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), modem means (modem 8, column 2, lines 54 through 60) for receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 5, lines 16 through 30), and a means (CPU 1, column 2, lines 38 through 41) for verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (step S110 in Fig. 6, column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is “collated” with the document sheet number of the document sheet in the queue), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (“no” in step S110 in Fig. 6, column 5, lines 31 through 40, wherein “if there is no matching document sheet, ... the process is terminated”), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (“yes” in step S110, which proceeds to step S111 to transmit the original image, column 5, lines

31 through 40, wherein “if there is a matching document sheet, the document sheet is transmitted”).

Regarding **claim 6**, Imai discloses a facsimile apparatus (see abstract, and Fig. 1) comprising memory for prestoring identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5, line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), modem (modem 8, column 2, lines 54 through 60) for receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 5, lines 16 through 30), and a controller (CPU 1, column 2, lines 38 through 41) for verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (step S110 in Fig. 6, column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is “collated” with the document sheet number of the document sheet in the queue), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (“no” in step S110 in Fig. 6, column 5, lines 31 through 40, wherein “if there is no matching document sheet, ... the process is terminated”), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory

(“yes” in step S110, which proceeds to step S111 to transmit the original image, column 5, lines 31 through 40, wherein “if there is a matching document sheet, the document sheet is transmitted”).

Regarding *claim 7*, Imai discloses a facsimile communication method for performing a Group 3 facsimile communications operation using an optional frame signal (column 1, lines 9 through 55, and column 3, lines 22 through 28) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5, line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 5, lines 16 through 40), and verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (step S110 in Fig. 6, column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is “collated” with the document sheet number of the document sheet in the queue), wherein when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory, standard facsimile operations that do not use the optional frame are performed while facsimile operations that would use the optional frame are canceled (“no” in step S110 in Fig. 6, column 5, lines 31 through 40, wherein “if there is no

matching document sheet, the absence of a document sheet is announced to the calling receiving station and the process is terminated").

Regarding *claim 8*, Imai discloses the apparatus discussed above in claim 5, and further teaches that the memory means stores a table of identification information identifying facsimile machines capable of operating with optional frames (column 5, line 19 through column 6, line 5, and column 8, lines 45 through 62).

Regarding *claim 9*, Imai discloses the apparatus discussed above in claim 6, and further teaches that the memory stores a table of identification information identifying facsimile machines capable of operating with optional frames (column 5, line 19 through column 6, line 5, and column 8, lines 45 through 62).

Regarding *claim 10*, Imai discloses a method for performing a facsimile communications operation using an optional frame signal (column 1, lines 9 through 55, and column 3, lines 22 through 28, being a SEP signal) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5, line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 5, lines 16 through 30), verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (step S110 in Fig. 6,

column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is "collated" with the document sheet number of the document sheet in the queue), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory ("no" in step S110 in Fig. 6, column 5, lines 31 through 40, wherein "if there is no matching document sheet, ... the process is terminated"), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory ("yes" in step S110, which proceeds to step S111 to transmit the original image, column 5, lines 31 through 40, wherein "if there is a matching document sheet, the document sheet is transmitted").

Regarding *claim 11*, Imai discloses a method for performing a facsimile communications operation using optional frame signals (column 1, lines 9 through 55, and column 3, lines 22 through 28, being a SEP signal) in a calling number display service mode (SEP signal included in the DTC signal, column 3, lines 22 through 58), comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (step S108, being a document sheet, designated by a document sheet number, stored in a polling queue, column 5, line 16 through column 6, line 36, whereby the document sheets numbers are different for each destination station, and document sheets for a plurality of destinations may be stored), receiving a telephone number of a calling facsimile machine during a call establishing process in the calling number display service mode and a signal requesting a facsimile communications operation using an

optional frame (column 5, lines 19 through 40, column 6, lines 9 through 62, being the polling document sheet number), verifying the telephone number of the calling facsimile machine received in the receiving step with the identification information prestored in the memory (step S110 in Fig. 6, column 5, lines 31 through 35, whereby the document sheet designated by the document sheet number is "collated" with the document sheet number of the document sheet in the queue), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory ("no" in step S110 in Fig. 6, column 5, lines 31 through 40, wherein "if there is no matching document sheet, ... the process is terminated"), and executing the facsimile communications operation using the optional frame when the telephone number of the calling facsimile machine corresponds to the identification information prestored in the memory ("yes" in step S110, which proceeds to step S111 to transmit the original image, column 5, lines 31 through 40, wherein "if there is a matching document sheet, the document sheet is transmitted").

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Imai *et al.* (U.S. Patent Number 6,104,504, cited in the Office action dated 7/15/03) in view of Yoshida (U.S. Patent Number 5,671,270, cited in the Office action dated 7/15/03).

Regarding *claim 2*, Imai discloses the method discussed above in claim 1, but fails to specifically teach if the identification information prestored in the memory comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine.

Yoshida discloses a facsimile communication method for performing a facsimile communications operation using an optional frame signal (see abstract) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (column 6, line 50 through column 7, line 25, and column 11, lines 6 through column 12, line 64), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 11, line 39 through column 12, line 21), and *verifying* the identification information of the calling facsimile machine with the identification information prestored in the memory (column 11, lines 6 through

16). Further, Yoshida teaches that the identification information prestored in the memory comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48) and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's teachings in the system of Imai. Imai's system would easily be modified to include Yoshida's teachings, as the systems share cumulative features, being additive in nature.

Conclusion

13. This is a continued examination of applicant's earlier Application No. 09/317,069. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp



EDWARD COLES
SUPERVISORY PATENT EXAMINER
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